



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,495	06/28/2001	Shinichi Yamada	057250903	5364

22852 7590 05/24/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,495

Applicant(s)

YAMADA ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 1, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 19, 20, 27-33, 52-54, 61, 56-58, 64-66, 69, 72-76, 79 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann (US 6110450) in view of Critchley et al. (US 5198210) ("Critchley").

The broadest claims in the instant case claim a composition comprising at least one ceramide, at least one fatty alcohol, and at least one cationic surfactant in a cosmetically acceptable medium, and a method of making and using the same, wherein the at least one fatty alcohol contains "no more than one hydroxyl group". While the claim requires at least one liquid fatty alcohol with only one hydroxyl group in the composition, examiner construes the claim in such a way that it does not exclude the presence of liquid fatty alcohols with more than one hydroxyl groups. See MPEP § 2111.03. Furthermore, excluding diols or triols from the composition is not supported by specification. See In re Grasselli, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983).

Bergmann discloses hair care composition comprising at least one ceramide and/or glycosphingolipid in a cosmetically acceptable medium. See abstract. Example 2 shows an aqueous formulation comprising oleoyldihydrosphingosine, cationic surfactants (components 1 and 4), and additives. The reference teaches using 0.001-1 % of phytantriol, which is a liquid fatty alcohol, with 0.001-1 % of ceramides. See col. 7, lines 39-45. The preparation of the example composition is also disclosed. See instant

claims 57 and 58. Cationic surfactants are taught in col. 6, lines 27 – 34. The reference teaches the application of the composition in permanent hair waving composition. See col. 7, lines 19 – 26. The methods for treating and protecting hair in instant claims 64, 65, 74, and 75 are obvious use of the prior art composition.

While Bergmann teaches formulations comprising cetyl and stearyl alcohols, which are solid, the reference fails to teach liquid fatty alcohols having one hydroxyl group.

Critchley teaches cosmetic compositions for skin, hair and nails which contains synthetic ceramides and emollients such as isocetyl alcohol, stearyl alcohol and cetyl alcohol. See col. 1, line 11 – col. 6, line 51; col. 10, lines 44 – 61. The reference suggests the equivalence of these alcohols which are well known emollients in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Bergmann by substituting the stearyl alcohol and cetyl alcohol with isocetyl alcohol, as motivated by Critchley, because 1) all references are directed to hair care compositions; 2) Critchley teaches the use of isocetyl alcohol with ceramides; and 3) Critchley teaches the equivalence of isocetyl alcohol with those fatty alcohols used in Bergmann. The skilled artisan would have combined the references in expectation of successfully producing hair care products with similar emolliency effects.

2. Claims 21-26, 34, 59, 60, 67, 68, and 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann and Critchley as applied to claims

19, 20, 27-33, 52-54, 56-58, 61, 64-66, 69, 72-76, 79, and 82 as above, and further in view of Maubru (US 6312674 B1).

Bergmann and Critchley fail to teach the specific ceramides of instant claims.

Maubru teaches oxidizing composition for bleaching or permanent reshaping hair, wherein the composition comprises ceramides disclosed in col. 3, line 21 – col. 16, line 13 in order to limit or prevent “deterioration in the mechanical properties of the hair”, particularly breaking of the hair and to obtain beautiful curls that withstand blow-drying and have good hold”. See col. 1, line 38 – col. 2, line 10. The reference specifically teaches bis(N-hydroxyethyl-N-cetyl)malonamide and 2-N-oleoylaminoctadecane-1,3-diol. See col. 5, lines 1 – 16. See instant claims 25-29. It is noted that oxidizing composition is used in “fixing step” in the permanent waving/straightening process. See col. 1, lines 1-29. Adding cationic polymers as a cosmetic additive is also suggested. See col. 5, lines 54 – 58; instant claim 19, 57, 64, and 74. The reference further teaches that the invention may contain other additives that are “known for their use in oxidizing compositions for bleaching or permanent reshaping of the hair”, and that the invention may be modified in the form of shampoo. See col. 5, lines 44 – 49. The claimed process of treating is necessarily practiced when the composition is used according to the teaching in the prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of the combined references by adding the ceramides of Maubru in the oxidizing bleaching or permanent waving compositions as motivated by Maubru because 1) both Bergman and Maubru teach

Art Unit: 1617

using ceramides in oxidizing bleaching or permanently reshaping compositions; and 2) Bergmann teaches that the specific ceramides therein limits and prevents breaking of hair and damage due to blow-drying, and produces beautiful curls. The skilled artisan would have been motivated to combine the references in expectation of successfully producing oxidizing bleaching or permanent reshaping compositions with good hair protection.

3. Claims 35-51, 62, 63, 70, 71, 80, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann, Critchley, and Maubru as applied to claims 19-34, 52-54, 56-61, 64-69, 72-79, and 82 above, and further in view of Dubief et al. (US 6120757) ("Dubief").

The combined references fail to teach the specific cationic surfactants of instant claims.

Dubief teaches aqueous dispersion comprising quaternary ammonium surfactants, which is useful for hair cosmetic compositions. See col. 4, line 51 – col. 6, line 2; see instant claims 35-51. The reference discloses that the invention can be used in permanent waving or straightening products or for washing or rinsing. See col. 6, lines 50 – 58.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. As shown by the recited teachings, the instant claims define nothing more than the concomitant

Art Unit: 1617

use of hair care ingredients. It would follow that the recited claims define prima facie obvious subject matter. Cf. In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

In this case, given the general teaching in Maubru that conventional additives for oxidizing composition for hair can be employed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Dubief for specific additives such as fatty alcohol and quaternary ammonium surfactants. The motivation to combine the ingredients to successfully formulate a hair composition for topical application is found in the teachings the prior arts that these are old and well known for hair treatment purposes.

4. Claims 35-51, 55, 62, 63, 70, 71, 80, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann and Critchley as applied to claims 19, 20, 27-33, 52-54, 56-58, 61, 64, 65, 69, 72-76, and 79 above, and further in view of Ochiai et al. (US 5587155) ("Ochiai").

Bergmann fails to teach 18-methyleicosanoic acid and quaternary ammonium cationic surfactants.

Ochiai teaches hair-conditioning composition comprising 18-methyleicosanoic acid. See Table 3; Example 7; col. 1, line 54 – col. 2, line 54. The reference teaches that the fatty acid prevents hair damage and adds resilience to the hair, and renders moisturizing and hair conditioning effects. See col. 7, lines 36 – col. 8, line 60 for the application of the invention, including shampoo and permanent waving compositions. Quaternary ammonium salts are taught in col. 3, line 36 – col. 5, line 51.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the Bergmann references by adding a well known hair conditioning ingredient such as 18-methyleicosanoic acid as motivated by Ochiai because of the expectation of successfully producing a hair care products with hair protection, moisturizing, and conditioning effects.

Response to Arguments

Applicant's arguments with respect to claims 19-82 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' assertion that Bergmann fail to teach the claimed invention is moot in view of the new grounds of rejection made in combination with Critchely, as discussed above.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1617


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER